UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS S. MESSERGES, EZZAT A. DABBISH,
LARRY PUHL, and DEAN VOGLER

Appeal 2007-1662
Application 09/942,010
Technology Center 2100

Decided: November 20, 2007

Before JOSEPH F. RUGGIERO, ANITA PELLMAN GROSS, and
JAY P. LUCAS, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

STATEMENT OF THE CASE

Messerges, Dabbish, Puhl, and Vogler (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1 through 53, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We find that the appeal is not in condition for a decision. This application is remanded to the Examiner to address the matters specified below and to take action deemed appropriate.

The present application was filed August 29, 2001, and claims priority under 35 U.S.C. § 119 from Provisional Application 60/284,739, filed April 18, 2001. The Examiner has rejected claims 1 through 13, 15 through 32, 34 through 36, and 38 through 53 under 35 U.S.C. § 102(e) and claims 14, 33, and 37 under 35 U.S.C. § 103(a) over Sweet, US 2002/0031230 A1, filed August 14, 2001, which falls between the priority date and the filing date of the present application. Sweet, however, claims priority under 35 U.S.C. § 119 from Provisional Applications 60/225,796, filed August 15, 2000, and 60/239,019, filed October 4, 2000, each of which antedates the priority date of Appellants' application.

Appellants challenged Sweet as prior art on page 15 of the response to the second non-final rejection (filed July 28, 2005) by stating:

> the relied upon teachings of Sweet et al., '230, … may not be prior art relative to the present application, in so far as the priority date of Sweet et al., '230, is based upon two provisional applications, which are minimally required for purposes of predating the priority date of the present application. It is noted that the Examiner's rejections have not yet made reference to corresponding teachings in the priority documents, and therefore, the Examiner has failed to establish priority of any of the relied upon portions of the cited reference.

Appellants made a similar statement at pages 14-15 of the response to the first non-final rejection (filed January 19, 2005). At page 6 of the Appeal Brief (filed June 21, 2006), Appellants repeated that the Examiner had failed to establish Sweet as prior art noting that "not all of the relied upon

teachings can be shown to be fully supported by a sufficiently early US filing from which the reference claims priority."

The Examiner's response to each of Appellants' challenges has been to refer to the dates of the provisional applications upon which Sweet relies and to conclude that Sweet, therefore, predates the priority date of the present application. (See, for example, Final Rejection 2 and Ans. 26.) At no point in the prosecution has the Examiner indicated where in the provisional applications support for the limitations relied upon can be found. Accordingly, Appellants (Reply Br. 2) asserted:

> With regards to the continued rejection of the claims based upon Sweet et al., '230, the priority applications from which Sweet et al., '230 claims priority are effectively technical publications, that bear little formal resemblance to the published application being relied upon in support of the rejection. In other words, there is no direct relationship between the particular language used in the latter filed application, and the priority documents from which priority is claimed, such that the alleged equivalent teaching does not directly map to a corresponding teaching in the priority applications, i.e. provisional applications USSN 60/225,796 and USSN 60/239,019.... In other words, most if not all of the paragraphs in the subsequently filed application do not correspond to any specific paragraph that can be found in either of the two priority documents.
>
> The Examiner has made no attempt to show support for the alleged equivalent teachings as being supported by the teachings of the above noted provisional applications from which the cited reference claims priority. In essence, to the extent that the rejection relies upon a teaching that is present in the published application, but which can not be similarly shown to be similarly taught by the application from which the application claims priority, the particular teaching can not reasonably be characterized as a prior teaching for purposes of

> rejecting the claims of the present application, as it would not be entitled to the date of the priority application.

The issue, thus, is whether Sweet is entitled to the August 15, 2000, filing date of Sweet Provisional Application 60/225,796 and/or the October 4, 2000, filing date of Sweet Provisional Application 60/239,019 under 35 U.S.C. §119. If Sweet is entitled to neither the August 15, 2000, or October 4, 2000, filing date, Sweet would be legally unavailable as prior art under 35 U.S.C. § 102(e). Therefore, until the record is made clear, it is premature for the Board to decide the appeal. Accordingly, upon remand of the application to the Examiner, the Examiner must make a determination as to whether Sweet is entitled to the claim, set forth on the patent, for benefit under 35 U.S.C. §119(e) of the August 15, 2000, filing date of Sweet Provisional Application 60/225,796 and/or the October 4, 2000, filing date of Sweet Provisional Application 60/239,019. That determination requires ascertaining whether the "invention [of Sweet] [is] disclosed in the manner provided by the first paragraph of section 112 of [35 U.S.C.]," 35 U.S.C. §119(e)(1). That entails ascertaining whether the Sweet provisional applications provide a written description of and enable the invention claimed in Sweet. Cf. In re Wertheim, 646 F.2d 527, 537 (CCPA 1981). Only after such a determination will the Examiner be in a position to reject the claims on appeal over Sweet.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if

a Supplemental Examiner's Answer is written in response to this remand by the Board.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

REMANDED

tdl/gvw

MOTOROLA, INC.
1303 EAST ALGONQUIN ROAD
IL01/3RD
SCHAUMBURG, IL 60196